



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Köster et al.

Serial No.: 09/171,625

Filed: July 2, 1999

For: A COMBINATORIAL PROTECTING
GROUP STRATEGY FOR
MULTIFUNCTIONAL MOLECULES

Art Unit: 1627

Examiner: Ponnaluri, P.

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Alicia Bradbury

PETITION PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed May 14, 2002, in connection with the above-captioned application. This Petition is filed within two months of the mailing of the final rejection.

It is respectfully submitted that the Office Action mailed May 14, 2002, (hereinafter the Office Action), which was made final, introduces new grounds of rejection that were not necessitated by amendment. Therefore, the Action should not have been made Final.

In the Office Action, claim 15 is rejected under 35 U.S.C. §112, first paragraph, as allegedly containing new matter. The Office Action alleges that "photolytic conditions" claimed in claim 15 has no clear support in the specification and claims as originally filed. It is further alleged that the subject matter claimed in claim 15 broadens the scope of the claims as originally

U.S.S.N. 09/171,625

Köster et al.

PETITION PURSUANT TO 37 C.F.R. §1.181

disclosed in the specification. Applicant respectfully traverses this finding for the following reasons.

Claim 15

Claim 15 as originally filed recited "A process of claim 12, wherein the linkage can be cleaved under acidic, alkaline, neutral or photolytic conditions". As amended, claim 15 reads "A process of claim 12, wherein the linkage is cleavable under acidic, alkaline, neutral or photolytic conditions".

Thus, the amendment only changes "can be cleaved" to "is cleaved" to amend the grammatical form, not the substance, of the claim. Therefore to the extent that amended claim 15 is rejected, original claim could have been so-rejected in a previous Office Action. Therefore, the new ground of rejection is not necessitated by the amendment.

Claims 4, 11-16

Claims 4 and 11-16 are rejected under 35 U.S.C. §112, first paragraph. It is urged that, specification, while being enabling for the use of specific linkers (npeoc, npc and nps) with specific reactions (deprotection reactions), does not reasonably provide enablement for any type of protecting groups and deprotection reagents. It is further alleged that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

It is stated in the Office Action that Applicant's amendment necessitated the new grounds of rejection. Applicant respectfully traverses this finding for the following reasons.

Claim 4 was rewritten in a previous response, dated August 27, 2001, as an independent claim, incorporating the limitations of the base claims (original claims 1 and 3). Claim 4 as originally filed recites "A process of claim 3, wherein the low molecular weight compound is selected from the group consisting of a saccharide, aminosugar, deoxysugar, nucleoside, nucleotide,


U.S.S.N. 09/171,625

Köster et al.

PETITION PURSUANT TO 37 C.F.R. §1.181

coenzyme, amino acid, lipid, steroid, vitamin, hormone, alkaloid and small molecule drug compound".

Original claim 1 recited "A process for generating a combinatorial set of molecules of core structure M, comprising the steps of:

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- (a) preparing a plurality of immobilized molecules of core structure M, wherein said molecules contain a plurality of reactive moieties, each reactive moiety being blocked by a blocking group, wherein at least three of the blocking group, wherein at least three of the blocking groups are independently removable under at least three different conditions; and
 - (b) removing certain blocking group and derivatizing the resulting reactive moiety in a preprogrammed, regioselective manner, wherein each member of a combinatorial set is uniquely derivatized at at least one reactive moiety with a unique substituent, thereby generating a combinatorial set of molecules of core structure M."

Original claim 3 recited "A process of claim 1 in which M is a multifunctional low molecular weight compound."

As amended, claim 4 now reads "A process for generating a combinatorial library, comprising the steps of:

- (a) preparing a plurality of immobilized molecules selected from a nucleoside and a nucleotide; wherein each molecule contains 3 to 10 reactive moieties, each reactive moiety being blocked by a blocking group, wherein at least three of the blocking groups on each immobilized molecule are independently removable under at least three different conditions; and
- (b) removing each blocking group and derivatizing the resulting reactive moiety in a preprogrammed, regioselective manner; wherein each member of the plurality of immobilized molecules is

U.S.S.N. 09/171,625

Köster et al.

PETITION PURSUANT TO 37 C.F.R. §1.181

uniquely derivatized at at least one reactive moiety with a unique substituent, thereby generating a combinatorial library."

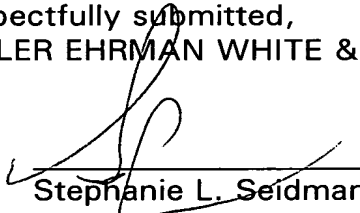
Thus the amendments to claim 4 did not add substantive new limitations, but rather merely incorporated the limitations of the base claims 1 and 3 as can be seen from comparison of these three claims. Incorporated limitations recite that the immobilized molecule is a nucleotide or nucleoside and that each molecule contains 3 to 10 reactive moieties. Therefore, to the extent that amended claim 4 is rejected under 35 U.S.C. §112, first paragraph, original claim 4 could have been so-rejected. Therefore the new ground of rejection is not necessitated by amendment.

Similarly, rejection of claims 11-16, which depend from claim 4 and its dependents, under 35 U.S.C. §112, first paragraph, as set forth above also was not necessitated by amendment of the claims.

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In light of the above remarks, reconsideration of the finality of the Office Action is respectfully requested.

Respectfully submitted,
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